



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,628	10/17/2003	Vivian Agura	03292.101740	2587
66569 7590 03/19/2008 FITZPATRICK CELLA (AMEX) 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
MYHRE, JAMES W				
ART UNIT		PAPER NUMBER		
3688				
MAIL DATE		DELIVERY MODE		
03/19/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/688,628

**Applicant(s)**

AGURA ET AL.

**Examiner**

JAMES W. MYHRE

**Art Unit**

3688

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 6-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. This Office Action is in response to the Amendment filed on January 15, 2008. The Amendment added new Claims 9-16, cancelled Claim 5, and amended Claims 1 and 4. Thus, the currently pending claims considered below are Claims 1-4 and 6-16.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4 and 6-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helbig (US 2002/0116257).

Claims 1 and 4: Helbig discloses a method for redeeming loyalty points, comprising:

- a. accessing a specified (identified) item and providing the amount of loyalty points needed to be redeemed for the item (page 6, paragraph 0061; page 7, paragraph 0073; and page 9, paragraphs 0093-0094);
- b. repeatedly collecting one or more specified items into a shopping cart (Figure 11; page 5, paragraph 0047; page 7, paragraph 0073; and page 9, paragraphs 0093-0094);

c. verifying the total amount of loyalty points needed for the specified items in the shopping cart (Page 5, paragraph 0047; page 7, paragraph 0073; and page 9, paragraphs 0093-0094);

d. processing the transaction (i.e. proceeding to the checkout and transferring the value of the loyalty points to the item(s) provider)(page 5, paragraph 0047; page 6, paragraph 0061; page 7, paragraph 0073; and page 9, paragraphs 0093-0094); and

e. converting the loyalty points into a different currency value and providing the value to the item(s) provider (page 11, paragraph 0127).

Helbig discloses converting one type of loyalty points into another type of loyalty points that are acceptable to the redeeming merchant. Helbig also discloses that the redemption product vendor server purchases the goods or services from participating issuers (page 7, paragraph 0073). This implies, or at least renders it obvious, to one having ordinary skill in the art at the time the invention was made that the loyalty points are converted into the equivalent amount of money and used to pay for the goods or services for which the loyalty points are being redeemed. It would have also been obvious that the conversion from loyalty points to money could be accomplished prior to, during, or after the redemption transaction was performed. One would have been motivated to perform such a conversion in order to complete the redemption transaction processing through the normal banking channels, i.e. to pay the merchant for supplying the goods/services to the customer.

Art Unit: 3688

Claims 2 and 7: Helbig discloses a method as in Claims 1 and 4 above, and further discloses the transactions are independent and dependent transactions (page 7, paragraph 0073 and page 9, paragraphs 0093-0094).

Claims 3 and 8: Helbig discloses a method as in Claims 1 and 4 above, and further discloses the items are tangible and non-tangible items (page 7, paragraph 0073 and page 9, paragraphs 0093-0094).

Claim 6: Helbig discloses a method as in Claim 4 above, and further discloses providing the amount of accumulated loyalty points to the user (page 7, paragraph 0073 and page 9, paragraphs 0093-0094).

Claims 9-16: Helbig discloses a method as in Claims 1 and 4 above, and further discloses the user may donate (convert) his earned loyalty points to another user, such as a family member, a friend, or to anyone (page 10, paragraph 0109). Official Notice is taken that it is also old and well known within the marketing arts to allow loyalty members to use their awards to invest in retirement accounts, donate to charities, buy life insurance, or receive cash. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Helbig to allow the customer to redeem the loyalty points for any one or more of these services. One would have been motivated to allow the customer to redeem loyalty points for investment, charitable, or bill paying purposes (i.e. convert to cash) in order to give the

consumer more redemption options, especially in view of Helbig's disclosure that such a wide variety of redemption programs were known (page 1, paragraph 0007).

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1 and 4 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES W. MYHRE whose telephone number is (571)272-6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 3688

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JWM

March 11, 2008

/James W Myhre/

Primary Examiner, Art Unit 3688